IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1977

No. 77-1046

MARCO DENTAL PRODUCTS, INC.,

Petitioner,

v.

GEORGE K. AUSTIN, JR.,

Respondent.

REPLY BRIEF BY PETITIONER

J. PIERRE KOLISCH
Attorney for Petitioner

KOLISCH, HARTWELL, DICKINSON
& STUART
1004 Standard Plaza
Portland, Oregon 97204
Of Counsel

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Respondent's brief in opposition to the Petition describes the patented invention in terms of "high speed drills (500,000 rpm)", "a reliable, inexpensive, and trouble free control for dental handpieces" contrasted to the prior art "complex, expensive, and unreliable" devices. There is nothing in Austin's patent, and particularly his claims, which calls for these "desirable benefits" that were never mentioned to the Patent Office, and which therefore cannot support validity of the patent. Graham v. John Deere Co., 383 U.S. 1, 25 (1966).

There are no "new" elements in the Austin patent.

In support of its argument that claim 1 of Austin is

valid, respondent argues (Brief, page 6 et. seq.) that the prior art did not disclose the diaphraghm valve and the hanger means called for in claim 1, and that since the claim contained new elements, "a finding of new and unusual results is unnecessary". According to respondent, the test of A & P and the cases which followed it[1], are inapplicable. All of these cases recognize that in mechanical patents there are no "new" elements. Mechanical patents are always made up of combinations of old elements and the test which this Court has insisted upon is whether the combination of such elements produces a synergistic result. The Ninth Circuit repudiated that by saying in this case that by finding existence of a "new" element the test is inapplicable. If that is the law in mechanical combination patent case it should emanate from this Court.

The diaphraghm valve was clearly old as evidenced by respondent's cancellation of claims 17, 18 and 19. Concerning the particular arrangement of passages and ports in the control block, that was shown in the Nielsen patent (DX 200 (P)). The only difference between Nielsen and Austin was that Austin controlled opening and closing of his ports by a flexible diaphraghm, whereas Nielsen used a spool valve.

Respondent states that another "new" element in claim 1 is the hanger means. This is contrary to the Austin patent which states that the hanger valve assembly and handpieces are old (column 2, lines 8-20). The hanger is nothing more than a hook for supporting a handpiece and the hanger is moved up and down by the weight of a handpiece to activate the unit. Nielsen does the same thing by unwinding a reel. If Austin's hanger construction

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1 Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147, 152 (1950); Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc., 396 U.S. 57, 61 (1969); Sakraida v. Ag Pro, Inc., 425 U.S. 273, 282 (1976)

is to be considered of patentable significance, then the prior art patents to Liedberg et al, 3,049,805, and Hertz, 3,313,025 (DX 200 (D), (α)) anticipate. Both of these patents show dental equipment having hangers for handpieces which control activation of the unit.

Since both of Austin's "new" elements, the diaphraghm valve and the hanger, are old, the sole question is whether Austin's combination of them produced a synergistic result. Neither of the lower courts found such a result, nor has respondent suggested one.

Austin commercially exploited his invention prior to critical date.

It is undenied that respondent, by his price lists and newsletter, offered to sell the patented device more than one year before the date of filing of his patent application. Neither of those offers contained any restriction or any indication that the offers to sell were for experimental purposes. That constituted commercial exploitation of the invention which placed it on sale under 35 U.S.C. § 102(b).

Respectfully submitted,

KOLISCH, HARTWELL,
DICKINSON & STUART

By_____
J. PIERRE KOLISCH
Attorneys for Petitioner